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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,938	01/17/2002	Eugene R. Zehler	M 5850A-OS/LUAP	3048

23657 7590 05/29/2003

COGNIS CORPORATION  
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EXAMINER
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KING, BRADLEY T

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/051,938

Applicant(s)

ZEHLER, EUGENE R.

Examiner

Bradley T King

Art Unit

3683

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 53, 79 and 80.

Claim(s) objected to: \_\_\_\_\_.


Claim(s) rejected: 38-40, 43, 46-48, 52, 55, 56, 59, 62-64, 67-70, 73, 76-78 and 81-84.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

Continuation of 5. does NOT place the application in condition for allowance because: it is maintained the rejections are proper. Regarding the 112 1st paragraph rejection, the incorporation by reference in the present application has been treated as proper. However, the instant application and the incorporation by reference fail to support the specific composition recited by claims 46-48, 62-64 and 76. The original disclosure only suggests that the esters can be made by the method described in US 5021179. The passages of 5021179 noted by applicant have been considered, but the passages are only further suggestions of the use of monovalent and divalent acids for esters. The recitation of monocarboxylic and dicarboxylic acids amended into the claims is more specific than the suggested "monovalent and divalent acids" incorporated by reference and therefore constitutes new matter. The specific combination of a fluid having a biodegradability of at least %80 and a carboxylic acid component comprising a mixture of two or more C5, C6, C7, C8 and C9 linear monocarboxylic acids with a dicarboxylic acid is not recited by the original disclosure and constitutes new matter. Also note In re Smith, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972).

Regarding the rejection under 35 USC 103, it is maintained the rejection is proper. Duncan discloses linear C810 acids (column 20, lines 49-50) which includes C6, and C8 acids. While C6 acid is not required, the composition including C6 and C8 acids is still disclosed.

  
JACK DAVINDER  
SUPERVISORY PATENT EXAMINER  
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